

REMARKS

The claims have been amended in order to overcome the grounds of rejection set forth in the previous official letter and to more particularly point out and distinctly claim the invention. Inasmuch as no new matter is introduced by the amendments, entry thereof is respectfully requested. Claims 1 and 3-7 are presently pending as set forth herein.

Applicant notes that there is now a new Examiner for this case.

On page 2 of the Office Action the Examiner states: "The terminal disclaimer filed on March 12 2007 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of 5140012979, 6010692, 6464970, 6706780 and 5350573 has been reviewed and is accepted the terminal disclaimer has been recorded." However, Applicant notes two items. First, the Examiner does not list either USP 5,140,016 or USP 5,632,979; both of which were included in the terminal disclaimer filed on March 12, 2007. Also, the Examiner lists 5140012979. Applicant does not know what this number refers to, as it is not a patent number. Correction and further elucidation is requested.

The Examiner also states that the terminal disclaimer filed on April 12 2006 related to USP 5,080,893 has been reviewed and is accepted. Applicant acknowledges this acceptance.

On pages 2 and 3 the Examiner objects to claim 5 under 37 CFR 1.75(c) as being of improper dependent form and further rejects claim 5 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the Examiner considers claim 5 as being broader than claim 1. Applicant traverses this rejection. It is a basic element of patent law that dependent claims incorporate the elements of the claims

from which they depend. However, in order to expedite allowance, Applicant has revised the claims such that dependent claim 5 now expressly excludes: "hyaluronic acid with molecular weights above about 1,500,000". Accordingly, withdrawal of this ground of rejection is respectfully requested.

On pages 3-5 of the Office Action the Examiner rejects claims 1, 3, and 6-7 as being unpatentable over Goldberg (USP 4,819,617, hereinafter the '617 patent). Applicant respectfully traverses this rejection. The '617 patent is directed to material for use in ophthalmic surgery, specifically this patent is directed to addressing the need for "viscous, gel-like compositions to fill the chambers of the eye to protect sensitive tissue such as the corneal endothelium from trauma." As disclosed these compositions comprise a solution of carboxymethyl cellulose having a molecular weight of 500,000 and above and are injected to retain the shape of the anterior chamber during surgery.

However, the present claims are directed to a method of protecting tissue and reducing tissue damage comprising coating surfaces involved in the surgery with a wet coating of a physiologically acceptable aqueous solution of a hydrophilic, polymeric material. Tissue and organ surfaces that are involved in surgery are susceptible to tissue damage and adhesions as a result of the manipulative trauma ischemic trauma and drying of the surfaces during the surgery. Further serious complications can result such as blood vessel damage leading to increased bleeding during surgery and/or post-operative hemorrhage, the enhancement of post-operative inflammation with prolongation of healing, compromised wound healing with excessive scar tissue, damage to organs and tissues resulting in impaired organ function, blood vessel damage resulting in reduced blood supply with concomitant partial ischemia of muscle tissues and organs, and increased susceptibility to acute and chronic infections due to the preferential adherence

and growth of pathogens on damaged tissue sites. The method of the present invention reduces such tissue damage and aids in the protection of tissue during surgery. As disclosed and claims, the method of the invention comprises providing the surfaces involved in the surgery with a wet coating of an aqueous solution of a hydrophilic, polymeric material prior to the manipulation of the tissue.

The solution disclosed by the '617 patent is a highly viscous gel, not suitable for forming wet coatings in an efficient manner on tissues involved in the types of surgeries where surgical adhesions are common. These gel-like materials of the '617 patent are employed to retain anterior chamber shape and are then washed out of the eye.

Applicant further notes that the present application is a Continuation in part of 08/026,125 (USP 5,350,573) filed on March 3, 1993; which is a continuation of 07/818,125 (Abandoned) filed on January 8, 1992; which is a Division of 07/696,960 (USP 5,140,016) filed on May 08, 1991; which is a continuation of 07/555,377 (USP 5,080,893) filed on July 19, 1990; which is a continuation of 07/199,687 (abandoned) filed on May 31, 1988. This filing date of May 31, 1988 pre-dates the '617 patent (date of patent April 11, 1989). Thus, Applicant further submits that the '617 patent is not a proper 103(a) reference.

Lastly, Applicant notes that a rejection based upon the '617 patent was overcome for example in related Goldberg patent 5,080,893. Applicant further notes that a terminal disclaimer was filed related to this patent to obviate a double patenting rejection. Therefore the '617 cannot do now what it could not do previously. Applicant therefore requests withdrawal of the rejection in view of the '617 patent.

On pages 6-9 of the Office Action the Examiner rejects claims 1, 4, and 6-7 as being unpatentable over Lambert (USP 4,585,666) in view of Schwartz et al (USP

4,589,873). Applicant respectfully traverses this rejection. Applicant notes that both Lambert and Schwartz have been cited in at least the following issued Goldberg patents: 5,080,893; 5,140,016; 6,010,692; and 6,706,780. Applicant further notes that terminal disclaimers have been filed to obviate a double patenting rejection over a “prior” patent for each of 5,080,893; 5,140,016; 6,010,692; and 6,706,780. These terminal disclaimers were filed in response to the prior Examiner’s argument that while the present claims were not identical, they were not patentably distinct from claims within these issued patents, because the instant claims claim polymers and molecular weights that overlap in scope with the patented claims. Applicant submits that Lambert in view of Schwartz cannot now do what it did not do previously. That is, given that Lambert in view of Schwartz did not render the claims in the above cited and previously issued patents obvious, it can not now render the present claims obvious.

Further, Applicant submits that Lambert discloses neither molecular weights nor the use of aqueous solutions. In addition, Schwartz discloses molecular weights only up to 1,000,000 (see col. 3, 55-59). Schwartz also does not disclose the use of aqueous solutions. Neither reference discloses or suggests the wet coating of tissue surfaces involved in invasive surgical techniques prior to surgery. As claims 1 and 3-7 are limited to materials not disclosed by either Lambert or Schwartz and as neither Lambert nor Schwartz, alone or in combination discloses or suggests the prior coating of tissues involved in surgery with a wet coating of the polymeric solutions of the present invention Applicant therefore submits that the combinations of recitations in claims 1 and 3-7 are patentable over the references of record, when each of the claims is interpreted as a whole. As neither Lambert nor Schwartz, alone or in combination discloses or suggests

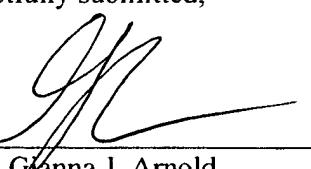
the combination of elements set forth in the pending claims, withdrawal of the rejection under 35 U.S.C. 103 is respectfully requested.

On pages 9-10 of the Office Action, the Examiner rejects claims 1, 3, and 6-7 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 9-14 of USP 4,819,617. Applicant traverses for the reasons set forth herein.

Applicants have earnestly endeavored to place the application in condition for allowance and an early action toward that end is respectfully requested. Should the Examiner believe that any further action is necessary to place this application in better form for allowance; the Examiner is invited to contact Applicants' representative at the telephone number listed below.

The Commissioner is hereby authorized to charge to Deposit Account No. 50-1165 (T2315-904733) any fees under 37 C.F.R. §§ 1.16 and 1.17 that may be required by this paper and to credit any overpayment to that Account. If any extension of time is required in connection with the filing of this paper and has not been separately requested, such extension is hereby requested.

Respectfully submitted,

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